

E. Colli

Application No.: 10/573,164

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Docket No.: 62138 (49949)

The Office Communication, on page 2, requires restriction to one of the following groups under 35 U.S.C. §121 and 372:

Group I, claims 2-4 and 9-22, drawn to a method of prevention or treatment of bladder dysfunction in a patient by administering a vitamin D compound.

Group II, claims 7 and 8, drawn to kits.

Applicants are required to elect one of the above groups for prosecution on the merits. Applicants respectfully traverse the requirements for restriction and election, and submit that the requirements are improper.

Applicants assert that the subject matter of these groups represent different embodiments of a single inventive concept for which a single patent should issue. The pending claims represent an intricate web of knowledge, continuity of effort, and consequences of a single invention, which merit examination in a single application.

The unifying concept of the claimed embodiments of the invention is the prevention and/or treatment of bladder dysfunction by administering a vitamin D compound in an amount effective to prevent and/or to treat such a disease. This is the core concept of the method claims of Group I and the kit claims of Group II and, in fact, is recited in the claims of both groups.

Notwithstanding the foregoing, Applicants submit that a sufficient search and examination with respect to the subject matter of all claims can be made without serious burden. As the M.P.E.P. states:

If the search and examination of an entire application can be made without serious burden, the examiner must examine it on the merits, even though it includes claims to independent or distinct inventions.

M.P.E.P. § 803 (8th ed., Rev. No. 5, August 2006).

That is, even if the above-enumerated groups of claims are drawn to distinct inventions, the Examiner must still examine the entire application on the merits because doing so will not result in a serious burden.

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Applicants submit that the search and examination of all the claims will have substantial overlap, and no serious burden will result from searching and examining all claims in the same application. This is especially true given the extensive computer databases and powerful search engines at the Examiner's disposal.

Those of ordinary skill in the art would best determine whether aspects of a given technology have acquired a separate status in the art. Applicants submit that one of ordinary skill in the art would not consider that the claims of Group I and II have acquired a separate status in the art.

Accordingly, in the interest of savings of time and cost to Applicants and the Patent Office, Applicants respectfully request that all the claims be searched and examined in a single application and that all groups be rejoined into a single group.

Nevertheless, in compliance with the directives in the Office Communication and in order to expedite prosecution of the instant application, Applicants hereby provisionally elect, subject to the foregoing traverse, Group I, claims 2-4 and 9-22, drawn to a method of preventing and/or treating bladder dysfunction.

Additionally, the Office Action indicates that a single species election is required for search purposes. Applicants traverse but hereby elect 1-alpha-fluoro-25-hydroxy-16,23E-diene-26,27-bishomo-20-epi-cholecalciferol, which is disclosed in claim 19. The claims readable on the elected species include claims 2-4, and 9-19.

If a telephone conversation with Applicants' attorney would help expedite the prosecution of the above-identified application, the Examiner is urged to call the undersigned attorney at (617) 239-0100.

It is respectfully submitted that the subject application is in condition for allowance. Early and favorable action is requested.

The Director is hereby authorized to charge any credits or deficiency in the fees filed (or with any paper hereafter filed in this application by this firm) to our Deposit Account No. 04-1105, under Order No. 62138 (49949).

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Respectfully submitted,

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